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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,011	01/18/2001	Glen Hale Paul JR.	6780-6	7255
4897	7590	10/25/2004	EXAMINER	
ROBERT C. KAIN, JR. 750 SOUTHEAST THIRD AVENUE SUITE 100 FT LAUDERDALE, FL 333161153			MANIWANG, JOSEPH R	
		ART UNIT		PAPER NUMBER
		2144		5
DATE MAILED: 10/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/765,011	PAUL ET AL. <i>G</i>
Examiner	Art Unit	
Joseph R Maniwang	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-60 is/are rejected.
- 7) Claim(s) 52-59 (renumbered 53-60), and 24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 January 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal and contain numerous discrepancies between the Specification and the actual figure reference elements shown. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: detailed description of figures omits description of numerous reference elements actually shown in drawings. Appropriate correction is required.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

4. For the purposes of examination, misnumbered claims 52-59 have been renumbered 53-60. Renumbered claim 53 was previously listed as a duplicate claim 52 in the original submission.

5. Claim 24 is objected to because of the following informalities: recitation of "A multi-modal method of communicating or communicating" in the preamble appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi et al. (U.S. Pat. App. Pub. 2002/0069116), hereinafter referred to as Ohashi, and further in view of Tucciarone et al. (U.S. Pat. App. Pub. 2003/0009385), hereinafter referred to as Tucciarone.

8. Ohashi disclosed a method and system for tracking the actions of a client over a network. The system included a web-based interface allowing a user to input user data, such as an e-mail communication data or a recipient e-mail address (see paragraphs [0008], [0009], [0022], [0041]). Other user data could include recipient data, or action data (see paragraph [0025]). Ohashi disclosed organizing user data in a data structure

(see paragraphs [0012]-[0013], [0026]-[0028], [0016]-[0017], [0042], [0079]-[0082]).

Ohashi disclosed creating an e-mail communication, and embedding a hyperlink in the e-mail (see paragraphs [0041], [0048], [0064]). The hyperlink pointed to a first web site (target URL), and further included a referral data packet (see paragraphs [0071]). The referral data packet was sent to a second web site (tracking server) upon actuation of the embedded hyperlink (see paragraph [0011]). Tracked information included such things as sponsor data, recipient data, campaign data, and member action data (see paragraphs [0043]-[0045]). Ohashi disclosed creating a list of e-mail recipients for broadcasting an e-mail to, the mailing list based on user criteria, such as members who have already taken an action or requested to opt-out (see paragraph [0048]). Ohashi disclosed reporting information on the receipt of referral packets as claimed (see paragraph [0055]).

9. While Ohashi disclosed a web-based interface for inputting communications data and e-mail addresses, Ohashi did not specifically disclose using the interface for inputting demographic data or personal data of a member. Additionally, Ohashi did not specifically disclose using the interface for inputting a pager, cellular telephone, or land-line telephone number, and sending an audio communication to the stored numbers.

10. In a related art of electronic messaging, Tucciarone disclosed a system for delivering commercial e-mail messages to users. Tucciarone disclosed a web-based interface for inputting user data into personal profiles (see paragraphs [0019], [0021], [0055]). Similar to the invention of Ohashi, the user data was used for generating customized e-mail messages based on the data inputted by the user (see paragraph

[0084]). Tucciarone disclosed using the interface for inputting user data such as demographic data and personal data regarding each user (see paragraphs [0120]-[0122]). Tucciarone further disclosed inputting the pager or phone number of a user for sending generated audio messages to (see paragraph [0119]).

11. It would have been obvious to one of ordinary skill in the art to combine the teachings of Ohashi and Tucciarone to provide a system for sending e-mail messages embedded with a hyperlink and a referral data packet to a plurality of members, including a web-based interface for inputting e-mail data, demographic data, and personal data as claimed. The combination of teachings would have further provided delivery of audio messages to a pager or phone number inputted by a user. Ohashi recognized that conventional methods of attracting customers were expensive and ineffective (see paragraph [0003]), and sought to overcome these shortcomings by allowing the transmission of referral e-mails recommending new customers to a merchant web site (see paragraphs [0004], [0007], [0041]). The e-mail system disclosed by Ohashi provided a user the option of opting-out (see paragraph [0048]). With such permission-based systems, Tucciarone recognized the potential problem of excessive commercial e-mail (see paragraphs [0005]-[0007]). The teachings of Tucciarone for allowing a user to input demographic and personal data attempted to solve this problem, and would have motivated one of ordinary skill in the art to consider incorporating a similar provision in the invention of Ohashi, as Tucciarone disclosed such a feature to provide the user more control and ease in use of the system, and more effective marketing for merchants (see paragraphs [0010], [0024]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kelly et al. (U.S Pat. No. 6,654,689)

Shaw et al. (U.S. Pat. No. 6,311,211)

Bates et al. (U.S. Pat. No. 6,769,015)

Henrick et al. (U.S. Pat. No. 6,377,936)

Henrick et al. (U.S. Pat. No. 6,055,510)

Bezos et al. (U.S. Pat. No. 6,029,141)

Brierley et al. (U.S. Pat. App. Pub. 2002/0161779)

Eichstaedt et al. (U.S. Pat. No. 6,654,735)

Dunn et al. (U.S. Pat. App. Pub. 2002/0082911)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (703) 305-3179 [Crystal City], (571) 272-3928 [Alexandria]. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (703)308-3873 [Crystal City], (571) 272-3925 [Alexandria]. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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